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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,150	03/03/2004	Yossi Oulu	MERCURY.199DV2	4847
22879 7590 12/24/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER COULTER, KENNETH R	
			ART UNIT 2441	PAPER NUMBER
			NOTIFICATION DATE 12/24/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/792,150	Applicant(s) OULU ET AL.	
	Examiner Kenneth R. Coulter	Art Unit 2441	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/2/04; 3/3/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent No. 6,792,460.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following mapping below.

Claim 1 of the present Application map to claims1, 7, and 8 (combined) of '460.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Hind et al. (U.S. Pat. Pub. No. 2004/0054695) (Problem Determination Method, System and Program Product).

1.1 Regarding claim 1, Hind discloses a method of instrumenting Java components installed on an application server in order to enable the Java components to be monitored, the method comprising:

adding a patch to a class loader class of a Java virtual machine installed on the application server, wherein the patch causes the class loader class to pass Java components to an instrumentation component when said Java components are loaded by the Java virtual machine (Figs. 3, 5; Abstract “**inserting** compiled problem determination **probes into program classes**”; paragraphs 36, 38);

receiving, from a patched version of said class loader class, code of a Java component to be loaded by the Java virtual machine (Figs. 3, 5; Abstract; paragraph 38); and

with the instrumentation component, instrumenting said code of the Java component to add functionality for tracking execution times (Figs. 3, 5; Abstract "Once the probes have been inserted, **the classes will be run and trace data will be generated.**"; paragraph 38 "inserting problem determination probes").

Paragraph 38 in Hind

The present invention addresses the issues with related art systems by providing a scheme for **inserting problem determination probes** into program classes while the subject system is running. Specifically, under the present invention, the problem determination probes are injected into the runtime of an object-oriented execution environment of a customer's system that interprets and/or incrementally compiles an intermediate virtualized instruction representation of that environment's object logic. One example of such an environment is JAVA where the intermediate virtual instructions resulting from compilation of source instructions are known as "bytecodes," which at run-time are loaded into a Java Virtual Machine (JVM) by a class loader. Once loaded, the bytecodes are directly interpreted and/or incrementally compiled by a just-in-time (JIT) compiler into native code for execution. It should be understood, however, that although JAVA terminology will be used in the following description, the teachings described herein could be applied in any environment.

1.2 Per claim 2, Hind teaches the method of claim 1, wherein instrumenting said code comprises adding calls to each of a plurality of methods of the Java component, to thereby provide functionality for monitoring execution times of said methods (Figs. 3, 5; Abstract; paragraphs 10, 38).

1.3 Regarding claim 3, Hind discloses the method of claim 1, wherein instrumenting said code comprises adding functionality for detecting when the Java component is invoked by a colored transaction request message (Figs. 3, 5; paragraph 44 "the logic is generated by parsing the rules to create a list of patterns that match all of the specific

classes that require the probes ...").

1.4 Per claim 4, Hind teaches the method of claim 1, wherein instrumenting said code comprises adding functionality for reporting transaction identifiers of transactions that invoke the Java component, to thereby allow said execution times to be associated with transactions to which they correspond (Figs. 3, 5; Abstract; paragraph 38).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Holiday U.S. Pat. No. 6,202,208 Patching Environment for Modifying a
JAVA Virtual Machine and Method

A JAVA patch for modifying a loader environment of a JVM (no tracking of execution times) (Abstract; col. 5, lines 36 – 55).

Berry et al. U.S. Pat. No. 6,738,977 Class Sharing Between Multiple Virtual
Machines

Blandy et al. U.S. Pat. No. 6,779,188 Apparatus and Method for Improved
Devirtualization of Method Calls

Bryant et al. U.S. Pat. No. 6,728,949 Method and System for Periodic Trace
Sampling Using a Mask to Qualify Trace Data

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A method of monitoring execution performance in which instrumentation code can be patched and a trace record is generated. (Figs. 3B, 23; col. 26, lines 6 – 19).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2441

/KRC/